

REMARKS

Reconsideration is respectfully requested.

The applicants have reviewed the Examiner's comments and the cited references and responsive thereto applicants have amended claims 12, 15, and 28, and have corrected an error in claim 17.

Claims 21 and 28 were rejected by the Examiner under 35 U.S.C. 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which applicants regard as the invention. Specifically, the Examiner had stated that the limitation "load bearing member" lacked antecedent basis. Responsive thereto, the applicants have amended claim 15 on which these claims directly depend by inserting the words "load bearing" in front of the word "member", and applicants respectfully submit that these claims now distinctly claim the subject matter which the applicants regard as the invention and that this rejection now be withdraw.

The Examiner has rejected claims 1-11, 13-27 and 29-35 under 35 U.S.C. 102(b) as being anticipated by Walth et al. (US 6,158,949). Regarding claim 1 (with claims 2-14 dependent thereon) the Examiner states, with respect to applicants' member and support member, that "there is reason to believe ...the second yield strength being greater than the first yield strength **may** be (an) inherent characteristic of the work machine load bearing arrangement." (emphasis mine). However, the applicants respectfully submit that the Examiner has not provided any objective rationale behind the belief that this is the case as required by the MPEP § 2112. As stated in the MPEP § 2112, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Furthermore, "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The applicants respectfully submit that the Examiner has failed to meet this hurdle of supporting his assertion of inherency, and if the Examiner is to sustain this rejection then applicants respectfully request that the Examiner substantiate his position in greater detail.

With regards to claims 4, 11, 20 and 27, the Examiner states that the added limitation of “laser welding”, as it relates to the attachment of the support members, adds no structure to the claims which the applicants presume is the basis of the rejection. However, applicants respectfully submit that rejecting these claims based on that assertion is erroneous. The Federal Circuit clearly has held that a patent applicant is free to recite features of an apparatus either structurally or functionally, and that functional limitations may be used to define an element by one of its characteristics or qualities (see, e.g., *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429 (Fed. Cir. 1997). The applicants further submit that in order for the Examiner to assert that this feature is an inherently taught characteristic of work machines, and as noted above, the Examiner is first required to provide a basis in fact and/or technical reasoning to reasonably support the determination that the alleged inherent characteristic necessarily flows from the teachings of the applied art, which the Examiner has failed to do (see, e.g., MPEP § 2112). For at least the reasons presented above, applicants respectfully submit that Walth fails to teach applicants invention as claimed and that this rejection be withdrawn.

Regarding claims 9, 10, 25, and 26, the Examiner states that Walth teaches a reinforcing structure (42) attached to at least one of the side plates (20,21), however, with reference to col. 3, lines 32-39 of Walth, the reinforcing structure (42) is actually attached to the coupling support structure 30 and to the top and bottom boom support structures (16, 18) and not to the side plate as claimed by the applicants. Furthermore, applicants are not clear how or where Walth teaches applicants claimed orientation of the reinforcing structure found in applicants claims 10 and 26. For at least the reasons presented above, applicants respectfully submit that Walth fails to teach applicants invention as claimed and that this rejection be withdrawn.

Regarding independent claim 15 (with claims 16-30 dependent thereon), applicants incorporate by reference applicants discussion above regarding claim 4 and respectfully again submit that, in light of the Federal Circuit’s holding that a patent applicant is free to recite features of an apparatus either structurally or functionally, and that functional limitations may be used to define an element by one of its characteristics or qualities, the

claimed characterization by the applicants of the pieces as being simulated for the effects of heat is proper and that the rejection of these claims is respectfully requested to be withdrawn.

Regarding independent claim 31 (with claims 32-35 dependent thereon), applicants comments made immediately above concerning claim 15 are again directly applicable and applicants respectfully submit that characterizing the weldment as being simulated for the effects of heat on at least one of the pieces is a proper manner to make this claimed characterization which is neither taught nor suggested by Walth. For at least the reasons presented above, applicants respectfully request that the rejection of claim 31 (with claims 32-35 dependent thereon) be withdrawn.

The Examiner has rejected claims 12 and 28 under 35 U.S.C. 103(a) as being unpatentable over Walth in view of Ginn et al. (US 6,409,459). In response thereto, applicants have amended claims 12 and 28 to make more clear that the two adjacent side plates that are to be coupled such that their respective centerlines are collinear each have a different thickness. For at least the reasons presented above, applicants respectfully submit that the combination of Walth and Ginn does not and cannot teach applicants invention as now claimed and that the rejection of claims 12 and 28 be withdrawn.

It is respectfully urged that the subject application is in condition for allowance and allowance of the application at issue is respectfully requested.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "James R. Smith", is written over a horizontal line.

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